

## **REMARKS**

Claims 1-10 were pending before this Response. Applicant has amended claims 1 -2 and 4-6, and cancelled claims 8-10, which were drawn to a non-elected invention, without prejudice to represent this claims in a divisional patent application. Applicant also added new claims 11-14 to more fully protect the invention.

### **The Claim Objections**

Applicant respectfully requests reconsideration of the objection to claim 1, in view of the amendment correcting the spelling of “arc” from “arch”.

### **The Rejections Under 35 U.S.C. §112**

Applicant respectfully requests reconsideration of the rejections of claims 1-7, under 35 U.S.C. §112, second paragraph. The Office Action states that “applicant should clarify the structure intended to have the plurality of segments”. In reply, applicant states that as set forth in claim 1 the magnetic is composed of a plurality of segments, and that it is each of these segments comprising the magnet that have the specified magnetization direction. It is the magnetization direction of the sections that “optimizes the magnetic field in a selected direction at an operating point”. It is also the magnetization direction that causes the magnetic field at the operating point vary by more than 180° when the magnet pivots through an arc of 90°. Applicant is claiming a magnet that is comprised of a plurality of segments, which segments are magnetized in the directions to achieve the specified results. Applicant respectfully submits that claims 1 through 7 particularly point out and distinctly claim the subject matter applicant regards as his invention.

### The Rejections Under 35 U.S.C. §103

Applicant respectfully requests reconsideration of the rejection of claims 1 – 7 under 35 U.S.C. §103 as unpatentable over Ritter et al., U.S. Patent No. 6,241,671, in view of Katznelson et al. et al., U.S. Patent No. 6,157,281. The Office Action states that “It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the segmented design of Katznelson et al. for the at least one magnet of Ritter et al, for the purpose of providing increased magnetic field control.”

However, the magnet that applicant claims in claim 1 is distinctly different from the Katznelson et al. magnet, and thus applicant’s claimed invention is not an obvious combination of Ritter et al. and Katznelson et al. et al. Claim 1 requires that the segments be magnetized in a “direction that optimizes the magnetic field in a selected direction at an operating point in front of the assembly” and further that the directions be such that “the pivoting of the magnet about an axis behind the magnet through an arc of less than 90° causes the magnetic field direction at the operating point to vary by 180°”. In contrast, the Katznelson et al. magnet is configured to produce a volume of substantially uniform magnetic field. This is different from applicant’s magnet in which the segments are magnetized to optimize the field at point, rather than over a volume. Furthermore, Katznelson et al. does not teach or suggest a magnet in which pivoting the magnet over an arc of about 90° results in a reversal of the magnetic field at an operating point.

The magnet that applicant claims in amended claim 2 is also distinctly different from the Katznelson magnet. Claim 2 requires a “magnet comprising a plurality of segments” in which “each segment having a magnetization direction so that the pivoting

of the magnet about an axis behind the magnet through an arc of less than  $90^\circ$  causes the magnetic field direction created by the magnet at an operating point spaced from the magnet to vary by  $180^\circ$ . This is not shown or suggested in Katznelson, which discloses a segmented magnet for creating a uniform field in a volume.

The magnet that applicant claims in claim 3 is also distinctly different from the Katznelson et al. magnet. Claim 3 requires a "magnet comprising a plurality of segments" which have magnetization directions such that "through a combination of pivoting and rotating the magnet projects a magnetic field in any direction at an operating point spaced from the front of the assembly." There is no teaching or suggestion in Katznelson et al. of a magnetization scheme in which the a magnetic field can be created at an operating point spaced from the magnet in any direction using only the specified movements. Katznelson et al. teaches a magnet that is designed to provide a uniform field, not a magnet that can provide a field at a point in any selected direction, with a minimum of magnet movement.

Claims 4 - 6 depend from claim 3, and are unobvious for the same reasons advanced above with respect to claim 3. Moreover claim 4 further specifies that the operating point is at least 12 inches from the magnet assembly, which is neither shown or suggested in Katznelson et al. Amended claim 5 further specifies that "the assembly can project a magnetic field at the operating point of at least 0.04T in any direction. Amended claim 6 further specifies that the assembly "can project a magnetic field at the operating point of at least 0.1 T in any direction."

Claim 7 is directed to a combination of first and second magnet assemblies disposed on opposite sides of a patient. Each magnet assembly comprising a magnet

mounted for pivoting about a first axis spaced from the magnet, and rotating about a second axis that is perpendicular to and intersects with the first axis. Each magnet comprises "a plurality of segments each with a magnetization direction such that through a combination of pivoting and rotating the magnet projects a magnetic field in any direction at an operating point spaced from the front of the assembly." This is not shown or suggested in Katznelson et al.

For at least these reasons, applicant respectfully submits that the invention as set forth in claims 1-7 would not have been obvious from Ritter et al. and Katznelson et al., and therefore the rejection is not patentable over Ritter et al. and Katznelson should be withdrawn.

#### Newly Presented Claims 11-14

Applicant is submitting new claims 11-14 to fully protect applicant's invention. Claim 11 depends from claim 3, shown above to be allowable and is allowable for at least the same reasons advanced above with respect to claim 3. Claims 12-14 depend from claim 7, shown above to be allowable, and are allowable for at least the same reasons advanced above with respect to claim 7.

#### Conclusion

Upon entry of the above amendments, and consideration of the above remarks, applicant respectfully submits that the rejection of claims 1-7 under §112 and 103 should be withdrawn, and claims 1-7 allowed. In addition, applicant respectfully submits

that newly presented claims 11-14 are similarly allowable, and a speedy allowance is respectfully requested.

Respectfully submitted,

Dated: June 14, 2004

By:   
Bryan K. Wheelock  
Reg. No. 31,441

HARNESS, DICKY & PIERCE, P.L.C.  
7700 Bonhomme, Suite 400  
St. Louis, Missouri 63105  
(314) 726-7500